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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,584	07/15/2003	Shoji Morita	023484-0150	6886
22428	7590	09/20/2006	EXAMINER	
FOLEY AND LARDNER LLP			DRODGE, JOSEPH W	
SUITE 500			ART UNIT	
3000 K STREET NW			PAPER NUMBER	
WASHINGTON, DC 20007			1723	

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/618,584

Applicant(s)

MORITA, SHOJI

Examiner

Joseph W. Drodge

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 8-19 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This Office Action is in response to the Amendment filed on December 2, 2005.

Claims 1-7 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In each of claims 1 and 20, it is unclear how a member can protrude from a portion of the cover or have any other structural relationship thereto, when the cover is removed and hence no longer forms a part of the oil filter.

Claims 1-7 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant Specification, especially at pages 7 and 8 does not support the newly added limitation of the inner tubular member increasing the total volume of the inner tubular member and the cover upon removal of the cover. Thus such limitation constitutes **NEW MATTER. Instead the Specification states that the inner tubular member is constructed and arranged such that first and second oil-collecting space volumes are altered upon removal of the cover from housing main body.**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ernst et al., U.S. Patent No. 5,698,098 in view of Fukumori et al., U.S. Patent No. 5,902,479.

Regarding Claim 1, Ernst discloses an oil filter comprising: a housing main body (#40 OR 10); a cover (#12) detachably attached to the housing main body on a vertically lower side thereof and having a recessed portion that opens toward a housing main body side; an inner tubular member (#15) interposed between the inner tubular member and the cover so as to be movable into and out of the recessed portion; a biasing unit (#18) for urging the inner tubular member in a direction to protrude from the recessed portion of the cover; and a filter element (#17) disposed in an oil flowing space defined between the housing main body and the cover for filtrating oil introduced thereinto; wherein the cover is in a state of being attached to the housing main body, the inner tubular member is pushed down into the recessed portion of the cover against a bias of the biasing unit (Fig. 1).

Upon removal of the cover, the tubular member would protrude from the former position of the recessed portion of the cover in one axial direction and from the side wall of housing 40/10 in an opposite axial direction, to give a slightly larger volume-holding area.

However, Ernst does not disclose an inlet and outlet or a seal member. Fukumori teaches an oil filter comprising a housing main body (#40) having an oil inlet (#42) and outlet (#43) and a seal member (#11) interposed between the cover and another member. It would have been obvious to one of ordinary skill in the art to modify Ernst with the element of Fukumori because they are both oil filters and in order be able to make a liquid-tight connection (Col. 2, Lines 43-45).

Regarding Claim 2, Ernst discloses that the total volume of the cover and the inner tubular member when the inner tubular member protrudes maximumly from the cover is set larger than the maximum volume of oil that can remain in a space between the housing main body and the cover upon the removal of the cover (Col. 3, Lines 36-45).

Regarding Claim 3, Ernst discloses that the filter element is detachably attached to the inner tubular member (Col. 2, Lines 63-64).

Regarding Claim 4, Ernst discloses that the cover is threadedly engaged (#13) with the housing main body.

Regarding Claim 20, Ernst also discloses an oil filter comprising: a housing main body (#40); a cover (#12) detachably attached to the housing main body on a vertically lower side thereof and having a recessed portion that opens toward a housing main body side; an inner tubular member (#15) interposed between the inner tubular member and the cover so as to be movable into and out of the recessed portion; a biasing unit (#18) for urging the inner tubular member in a direction to protrude from the recessed portion of the cover; and a filter element (#17) disposed in an oil flowing space defined between the housing main body and the cover for filtrating oil introduced thereinto; wherein the cover is in a state of being attached to the housing main body, the inner tubular member is pushed down into the recessed portion of the cover against a bias of the biasing unit (Fig. 1); and wherein the cover has an oil collecting portion at the bottom side outer circumferential periphery thereof (between #12 and #15). However, Ernst does not disclose an inlet and outlet or a seal member. Fukumori teaches an oil filter comprising a housing main body (#40) having an oil inlet (#42) and outlet (#43) and a seal member (#11) interposed between the cover and another member. It would have been obvious to one of ordinary skill in the art to modify Ernst with the element of Fukumori because they are both oil filters and in order be able to make a liquid-tight connection (Col. 2, Lines 43-45).

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3. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ernst in view of Fukumori as applied to Claim 1 above, and further in view of Faria, U.S. Patent No. 5,066,391.

Regarding Claim 5, Ernst discloses that the inner tubular member (#15) but does not disclose a partition wall or communication hole. Faria teaches an oil filter (#10) where the inner tubular member comprises a tubular wall (#78) and a partition wall (#74, 112) closing an end of the tubular wall, at least one of the tubular wall and the partition wall of the inner tubular member being provided with a communication hole (#110) for providing communication between the upper and lower oil collecting chambers. It would have been obvious to one of ordinary skill in the art to modify Ernst with the element of Faria in order to provide a passageway when the oil pressure exceeds a predetermined value (Col. 5, Lines 31-36).

Regarding Claim 6, Ernst discloses that the total volume of the cover and the inner tubular member when the inner tubular member protrudes maximumly from the cover is set larger than the maximum volume of oil that can remain in a space between the housing main body and the cover upon the removal of the cover (Col. 3, Lines 36-45).

Regarding Claim 7, Faria discloses that the communication hole is formed in the inner tubular member at the position thereof corresponding to the lowermost position (Fig. 2).

***Allowable Subject Matter***

4. Claims 8-19 are allowed.

The following is an examiner's statement of reason for allowance:

The prior art of record neither teaches nor suggests a biasing unit that holds the partition member pressed against the housing main body so that the volume of the oil suction chamber increases as the cover is moved increasingly away from the housing main body upon removal of the cover. Baumann et al., U.S. Patent No. 6,65,829 B1 discloses an oil filter comprising a partition member disposed in the recessed portion of the cover so as to be movable into and out of the recessed portion and partitioning a space between the cover and the housing main body but does not disclose a biasing unit that presses the partition member against the housing. Although Ernst et al., U.S. Patent No. 5,698,098 does teach a biasing unit, it would not have been obvious to one of ordinary skill in the art to modify Baumann with the element of Ernst.

***Response to Arguments***

Applicant's arguments filed on July 14, 2006 have been fully considered but they are not persuasive. It is argued that Ernest does not suggest the newly added limitation regarding protruding of the inner tubular member disposed within the cover. However, it is submitted that in Ernest such member both protudes in one axial direction from the housing main body and in an opposite axial direction from the cover. The newly added limitation also raises new U.S.C. 112, first and second paragraph issues.



**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph W. Drodge whose telephone number is 571-272-1140. The examiner can normally be reached on 8:30-5:00 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Joseph Drodge*  
JOSEPH DRODGE  
PRIMARY EXAMINER

JWD

09/15/06